



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 9

Carl B. Horton
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41 Woodford Avenue
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In re Application of
Roger Castonguay, et al
Application No. 09/275,066
Filed: March 23, 1999
Attorney Docket No. 41PR-7566

DECISION ON PETITION UNDER
37 CFR 1.183 SEEKING WAIVER
OF REQUIREMENTS UNDER 37 CFR
1.98

This is a response to a May 31, 2000 Petition Under 37 CFR 1.183, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of U.S. patent references in each of many related applications where the U.S. patents are being cited by Petitioner.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of U.S. patent IDS citations is Granted to the extent set forth below.

The Decision is set forth in four parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.183 - Paper Copies
- Part III. Summary
- Part IV. Further Correspondence

Part 1. Background

The instant application filed under 35 U.S.C. 111 is one of about 90 U.S. applications (either filed or to be filed) relating to different aspects of an invention. An Information Disclosure Citation List has been submitted that lists 170 U.S. patents and 51 foreign patent documents for a total of 221 citations. Additionally, a list of related cases has been supplied containing 64 U.S. applications (Appendix I of the petition). Almost all the applications that have been classified have been classified in one particular art unit. Copies of all foreign references have been

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submitted in each of the filed applications (petition, page 1, 1.b.).

Petitioner's recitation to "U.S. references" has been interpreted to mean U.S. patents (U.S. patent references) as opposed to including U.S. originated journal articles. 37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Rather than be required to submit, via a paper copy, each U.S. patent (petition, bridge of pages 2, 3) in each application, Petitioner seeks to have:

- (1) Three complete sets of paper copies of each IDS citation submitted;
- (2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;
- (3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing the paper set of U.S. patents; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent), and a copy of each foreign reference (no U.S. literature references are currently identified but it is assumed that U.S. literature references would be treated similar to foreign references).

The paper references are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

The petition does not mention how the information supplied via the compendium would be updated even though the Technology Center believes that it is intended to be updated.

Part II. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column.

Paper copies: Petitioner notes that the instant application is one of 90 bulk filing applications that

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will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each U.S. patent citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Once past the initial IDS submission, the proposal is silent as to whether applicant wishes the waiver to apply to updates.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (petition, page 3) with reference numbering in the three copies of the reference compendium corresponding to the numbering in the Form 1449. Although not discussed in the petition it is the Technology Center's understanding that the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of U.S. patents), the petition states that upon allowance of the instant holding application, the application can remain as the holding application (petition, page 4). An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner seeks a right of termination (petition page 4), which is to be a mutual option. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in 90 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's

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point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.¹

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications provided that the following 8 conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

¹The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., §§ 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.
- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,² or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8 There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

Part III. Summary

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

²The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either a reference set of paper copies (produced from the three sets of copies to be submitted) could be utilized, or the Office may decide to create Digests from the compendium.

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- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed.

Part IV. Further Correspondence

Further correspondence with respect to this matter should be addressed to Michael L. Lewis, Legal Advisor, Office of Patent Legal Administration, as follows:

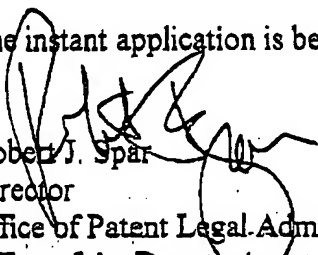
By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Office of Patent Legal Administration
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Lewis at (703) 306-5585.

The instant application is being forwarded to the Technical Center for further action on the merits.


Robert J. Spar
Director

Office of Patent Legal Administration
Office of the Deputy Assistant Commissioner
for Patent Examination Policy



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Zweigstelle
in Den Haag
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Branch at
The
Sear.
division

d s brevets
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MAILED TO

10 APR 2000

IPO

LONDON PATENT OPERATION
10 APR 2000

RECEIVED WITH THANKS

Datum/Date

07.04.00

Zeichen/Ref./Réf. 75DE-00509/7034	Anmeldung Nr./Application No./Demande n°/Patent Nr./Patent No./Brevet n° 99308745.1-2302-
Anmelder/Applicant/Demandeur/Patentinhaber/Proprietor/Titulaire AEG Niederspannungstechnik GmbH & Co. KG	

U.S. Pending

COMMUNICATION

The European Patent Office herewith transmits as an enclosure the European search report for the above-mentioned European patent application.

If applicable, copies of the documents cited in the European search report are attached.

☒ Additional set(s) of copies of the documents cited in the European search report is (are) enclosed as well.

The following specifications given by the applicant have been approved by the Search Division:

☒ abstract

☒ title

☐ The abstract was modified by the Search Division and the definitive text is attached to this communication.

The following figure will be published together with the abstract: 1

RECEIVED

APR 11 2000

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GENERAL ELECTRIC CO.

REFUND OF THE SEARCH FEE

If applicable under Article 10 Rules relating to fees, a separate communication from the Receiving Section on the refund of the search fee will be sent later.





DOCUMENTS CONSIDERED TO BE RELEVANT

Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (Int.Cl.7)
A	EP 0 889 498 A (AEG NIEDERSpannungSTECH GMBH) 7 January 1999 (1999-01-07) * the whole document *	1-8	H01H73/04
A	US 5 357, 066 A (MOREL ROBERT ET AL) 18 October 1994 (1994-10-18) * abstract; claims; figures *	1-8	
A	EP 0 560 697 A (MERLIN GERIN) 15 September 1993 (1993-09-15) * the whole document *	1-8	
A	EP 0 314 540 A (MERLIN GERIN) 3 May 1989 (1989-05-03) * abstract; claims; figures *	1-8	
A	US 5 298 874 A (NEBON JEAN-PIERRE ET AL) 29 March 1994 (1994-03-29) * abstract; claims; figures 1,6 *	1-8	
			TECHNICAL FIELDS SEARCHED (Int.Cl.7)
			H01H
The present search report has been drawn up for all claims			
Place of search THE HAGUE		Date of completion of the search 3 April 2000	Examiner Durand, F
CATEGORY OF CITED DOCUMENTS			
X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document			

ANNEX TO THE EUROPEAN SEARCH REPORT
ON EURO AN PATENT APPLICATION NO.

EP 99 30 8745

This annex lists the patent family members relating to the patent documents cited in the above-mentioned European search report.
The members are as contained in the European Patent Office EDP file on
The European Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

03-04-2000

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
EP 0889498 A	07-01-1999	IT MI971564 A	04-01-1999
		JP 11144598 A	28-05-1999
		PL 327159 A	04-01-1999
		SG 67517 A	21-09-1999
US 5357066 A	18-10-1994	FR 2683089 A	30-04-1993
		DE 69224035 D	19-02-1998
		DE 69224035 T	02-07-1998
		EP 0540431 A	05-05-1993
		ES 2112306 T	01-04-1998
		JP 5217486 A	27-08-1993
EP 0560697 A	15-09-1993	FR 2688626 A	17-09-1993
		DE 69304374 D	10-10-1996
		DE 69304374 T	20-02-1997
		ES 2092792 T	01-12-1996
		JP 6052777 A	25-02-1994
		US 5310971 A	10-05-1994
EP 0314540 A	03-05-1989	FR 2622347 A	28-04-1989
		DE 3884557 D	04-11-1993
		DE 3884557 T	05-05-1994
		JP 1166429 A	30-06-1989
		JP 2666828 B	22-10-1997
		US 4910485 A	20-03-1990
US 5298874 A	29-03-1994	FR 2682530 A	16-04-1993
		AT 148960 T	15-02-1997
		AU 660489 B	29-06-1995
		AU 2639692 A	22-04-1993
		CA 2080064 A	16-04-1993
		CN 1071784 A, B	05-05-1993
		DE 69217441 D	27-03-1997
		DE 69217441 T	10-07-1997
		EP 0538149 A	21-04-1993
		ES 2099235 T	16-05-1997
		JP 5217489 A	27-08-1993
		MX 9205924 A	01-04-1993
		ZA 9207904 A	21-04-1993

**AUSTRALIAN PATENT OFFICE
SEARCH REPORT**

Application No.
SG 9801523-3

A. CLASSIFICATION OF SUBJECT MATTER

According to International Patent Classification (IPC)
Int Cl⁶ H01H 73/04, 77/10

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)
IPC H01H 73/04, 77/10

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the search (name of data base and, where practicable, search terms used)
WPAT

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	WO 9200598 A (ASEA BROWN BOVERI AB) 9 January 1992 see abstract	
A	EP 399282 A (BTICINO srl) 28 November 1990 see abstract	
A	GB 2233155 A (DELTA CIRCUIT PROTECTION & CONTROLS LTD) 2 January 1991 see abstract	

☒ Further documents are listed in the continuation of Box C

☒ See patent family annex

<p>*Special categories of cited documents:</p> <p>"A" document defining the general state of the art which is not considered to be of particular relevance</p> <p>"E" earlier document but published on or after the filing date</p> <p>"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)</p> <p>"O" document referring to an oral disclosure, use, exhibition or other means</p> <p>"P" document published prior to the filing date but later than the priority date claimed</p>		<p>"T" Later document published after the filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention</p> <p>"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone</p> <p>"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art</p> <p>"&" document member of the same patent family</p>
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Date of submission of the request to the Australian Patent Office
8 June 1999

Date of completion of the search report
27 July 1999

Date of mailing of the search report

6-8-99

Name and mailing address
AUSTRALIAN PATENT OFFICE
PO BOX 200
WODEN ACT 2606
AUSTRALIA
Facsimile No.: 61 2 62853929

Authorised officer

M.S. HAYNES

**AUSTRALIAN PATENT OFFICE
SEARCH REPORT**

**Application No.
SG 9801523-3**

C (Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	US 5281776 A (MOREL et al) 25 January 1994 see abstract	
A	US 4649247 A (PREUSS et al) 10 March 1987 see abstract	

AUSTRALIAN PATENT OFFICE SEARCH REPORT				PATENT FAMILY MEMBERS		Application No. SG 9801523-3	
Patent Document Cited in Search Report				Patent Family Member			
WO	9200598	SE	9002264				
EP	399282	IT	1230203				
GB	2233155	NIL					
US	5281776	AU	26397/92	BR	9203982	CA	2080063
		CN	1071785	EP	542636	FR	2682531
		JP	6028964	MX	9205923	ZA	9207903
US	4649247	CA	1258283	DE	3431288	EP	174904
		JP	61061319	MX	160683		

END OF ANNEX

AUSTRALIAN PATENT OFFICE

EXAMINATION REPORT

Applicant's or agents file reference GM/RN/G2-313/EN		
Application No. SG 9801523-3	Application filing date (day/month/year) 25 June 1998	Priority Date (day/month/year) 2 July 1997
International Patent Classification (IPC) as indicated in the search report or the Request, if no indication in the search report Int Cl. ⁶ H01H 73/04, 77/10		
Applicant AEG NIEDERSpannungSTECHNIK GMBH & CO KG		

1.	This REPORT consists of a total of 4 sheets.
2.	This report contains indications relating to the following items: I <input checked="" type="checkbox"/> Basis of the report II <input type="checkbox"/> Priority III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability IV <input type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input type="checkbox"/> Certain defects in the application VIII <input checked="" type="checkbox"/> Certain observations on the application
3.	The search report used was issued by the Australian Patent Office and the date of completion is 27 July 1999.

Date of submission of the request to the Australian Patent Office 8 June 1999	Date of mailing of the report 6-8-99
Name and mailing address AUSTRALIAN PATENT OFFICE PO BOX 200 WODEN ACT 2606 AUSTRALIA Facsimile No. 61 2 62853929	Authorized Officer M.S. HAYNES

AUSTRALIAN PATENT OFFICE
EXAMINATION REPORT

Application No.
SG 9801523-3

I. Basis of the report

1. This report has been drawn on the basis of

☒ the application as originally filed.

☐ the description, pages , as originally filed,
 pages , filed with the request,
 pages , filed with the letter of ,
 pages , filed with the letter of ,

☐ the claims, pages , as originally filed,
 pages , filed with the request,
 pages , filed with the letter of ,
 pages , filed with the letter of .

☐ the drawings, sheets/fig , as originally filed,
 sheets/fig , filed with the request,
 sheets/fig , filed with the letter of ,

2. The amendments have resulted in the cancellation of: pages:

 sheets of drawings/figures No:

☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box

4. Additional observations, if necessary:

II. Priority

1. ☐ This report has been established as if no priority had been claimed due to failure to furnish:

☐ copy of the earlier application whose priority has been claimed.

 or ☐ translation thereof if the earlier application whose priority has been claimed.

2. ☐ This report has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid.

Thus for the purposes of this report, the filing date indicated above is considered to be the relevant date.

AUSTRALIAN PATENT OFFICE
EXAMINATION REPORT

Application No.
SG 9801523-3

V. Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. STATEMENT

Novelty (N)	Claims	1-19	YES
	Claims		NO
Inventive step (IS)	Claims	1-19	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-19	YES
	Claims		NO

2. CITATIONS AND EXPLANATIONS

Claims 1-19

The present invention relates to a circuit breaker having the features outlined in claim 1.

No citation or obvious combination of citations disclose this arrangement.

The closest art is WO 9200598 A (ASEA BROWN BOVERI AB) which discloses a circuit breaker having a different arrangement than that shown in the present application.

AUSTRALIAN PATENT OFFICE
EXAMINATION REPORT

Application No.
SG 9801523-3

VIII. Certain observations on the application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

☒ The claimed invention is patentable according to Section 13(3); or

☐ The claimed invention is unpatentable according to Section 13(3) because: